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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,887	02/04/2004	Charles H. Perrone JR.	2108.003700	3884

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EXAMINER

SCHILLINGER, ANN M

ART UNIT PAPER NUMBER

3738

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/771,887	Applicant(s) PERRONE ET AL.	
	Examiner Ann Schillinger	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 10-16, 18, 19, 21, 22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 10-16, 18, 19, 21, 22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 7, 10-13 and 15, 16, 18, 19, 21, 22, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (U.S. Pat No. 6,306,172). O'Neil discloses all of the following regarding claim 1: a device, comprising: a tibia base plate (78); an insert (86) adapted to be positioned above said base plate; and at least one removable pin (88) wherein when installed, a first portion of said pin is configured to engage an opening formed in a perimeter side surface of said base plate and a second portion of said pin is configured to engage an opening formed in a perimeter side surface of said insert (in Figure 9A, pin 88 goes through both the insert and base plate) to thereby prevent relative rotation between said insert and said base plate (col. 7, lines 6-14; Figures 7A, 9A). It should be noted that here the examiner is interpreting the word "perimeter" as any boundary of an area, therefore allowing the O'Neil reference to still read on the claims. Also, the claim language in line 9 that is "to thereby prevent relative motion between said insert and said base plate," has been read as functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

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O'Neil also discloses all of the following regarding claim 15: a device, comprising: a tibia base plate (78); an insert (86) adapted to be positioned above said base plate; wherein when installed, a first portion of said pin is configured to engage an opening formed in a perimeter side surface of said base plate and a second portion of said pin is configured to engage an opening formed in a perimeter side surface of said insert (shown in Figure 2) to thereby prevent relative rotation. (col. 7, lines 6-14; Figures 7A, 9A).

O'Neil also discloses all of the following regarding claim 16: device of claim 15, wherein said removable means for preventing relative rotation between said insert and said base plate comprises a removable pin (88).

O'Neil discloses claims 2 and 18 which state that the base plate is comprised of a metal in col. 1, lines 19-21.

O'Neil discloses claims 3 and 19 which state that the insert is comprised of a non-metallic material in col. 1, lines 32-34.

O'Neil discloses all of the following regarding claim 21: the device wherein said pin is located adjacent an anterior portion of said base plate has an outer surface that is substantially flush with a perimeter side surface of one of said base plate and said insert (shown in Figure 9A).

O'Neil discloses the press-fit connection of claims 6 and 22 with an interference connection that works in the same manner as the press-fit connection (col. 6, lines 31-32).

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O'Neil discloses all of the following regarding claim 7: the device of claim 1, wherein said pin wherein said pin has an outer surface (106) that is substantially flush with said perimeter side surface of one of said base plate and said insert (shown in Figure 9A).

O'Neil discloses all of the following regarding claims 10 and 24: the openings in said tibia base plate and said insert are formed on the anterior perimeter side surfaces of base plate and said insert, respectively (element 102 progresses through the anterior ends of 78 and 86).

O'Neil discloses all of the following regarding claims 11, 12, 25, and 26: the device wherein said pin has at least one of a circular, rectangular and square cross-sectional configuration and has a smooth exterior surface (col. 6, lines 22-23).

O'Neil discloses all of the following regarding claims 13 and 27: the device wherein said pin has at least one projection formed on an exterior surface of said removable means (110 or 108; col. 6, lines 33-38).

Claims 1, 2, 3, 6, 7, 10-12, 15, 16, 18, 19, 21, 22, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bloebaum et al. (U.S. Pat. No. 4,883,488). Bloebaum et al. discloses all of the following regarding claim 1: a device, comprising: a tibia base plate (32, 34); an insert (58, 60) adapted to be positioned above said base plate; and at least one removable pin (62,64) wherein when installed, a first portion of said pin is configured to engage an opening formed in a perimeter side surface of said base plate and a second portion of said pin is configured to engage an opening formed in a perimeter side surface of said insert (shown in

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Figure 2) to thereby prevent relative rotation between said insert and said base plate (col. 6, lines 32-36). It should be noted that here the examiner is interpreting the word “perimeter” as an outer boundary of an area, therefore allowing the Bloebaum et al. reference to read on the claims.

Bloebaum et al. also discloses all of the following regarding claim 15: a device, comprising: a tibia base plate (32, 34); an insert (58, 60) adapted to be positioned above said base plate; and a removable means (62, 64) for preventing relative rotation between said insert and said base plate (col. 6, lines 32-36) wherein when installed, a first portion of said pin is configured to engage an opening formed in a perimeter side surface of said base plate and a second portion of said pin is configured to engage an opening formed in a perimeter side surface of said insert (shown in Figure 2) to thereby prevent relative rotation.

Bloebaum et al. also discloses all of the following regarding claim 16: device of claim 15, wherein said removable means for preventing relative rotation between said insert and said base plate comprises a removable pin (62, 64).

Bloebaum et al. discloses claims 2 and 18 that state that the base plate is comprised of a metal in col. 7, lines 5-8.

Bloebaum et al. discloses claims 3 and 19 that state that the insert is comprised of a non-metallic material in col. 6, lines 40-45.

Bloebaum et al. discloses the press-fit connection of claims 6 and 22 with an interference connection that works in the same manner as the press-fit connection (col. 6, lines 32-35).

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Bloebaum et al. discloses all of the following regarding claim 7: the device of claim 1, wherein said pin has an outer surface that is substantially flush with said perimeter side surface of one of said base plate and said insert (shown in Figure 2).

Bloebaum et al. discloses all of the following regarding claims 10 and 24: the openings in said tibia base plate and said insert are formed on the anterior perimeter side surfaces of base plate and said insert, respectively (shown in Figure 2).

Bloebaum et al. discloses all of the following regarding claims 11, 12, 25, and 26: the device wherein said pin has at least one of a circular, rectangular and square cross-sectional configuration and has a smooth exterior surface (shown in Figure 4).

Bloebaum et al. discloses all of the following regarding claims 13 and 27: the device wherein said pin has at least one projection formed on an exterior surface of said pin (110 or 108; col. 6, lines 33-38).

Bloebaum et al. discloses all of the following regarding claim 21: the device of claim 15, wherein said removable means for preventing relative rotation between said insert and said base plate has an outer surface that is substantially flush with a perimeter side surface of one of said base plate and said insert (shown in Figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. in view of Smith (U.S. Pat. No. 5,108,442). O'Neil et al. discloses that the various parts of the implant device can be made from a variety of materials including metals and non-metals (col. 1, lines 19-21). The reference, however, does not specifically disclose that the pin used in the implant is made of a metal. Smith teaches the metal pin of claims 14 and 28 in col. 3, lines 9-11.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use metal for the pin to accommodate for the knee's full range of motion and give the implant's pin its desired strength and durability.

Claims 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloebaum et al. et al. in view of O'Neil et al. (U.S. Pat. No. 6,306,172). Bloebaum et al. et al. does not disclose anti-rotation pins that have at least one projection formed on the exterior surface of the pin. O'Neil teaches such a feature in elements 110 or 108 and in col. 6, lines 33-38. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use a projection on the pin to further secure the tibia base plate and the insert.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloebaum et al. et al. in view of Smith (U.S. Pat. No. 5,108,442). Bloebaum et al. et al. discloses that the various parts of the implant device can be made from a variety of materials including

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metals and non-metals, but the reference does not specifically disclose that the pin used in the implant is made of a metal. Smith teaches the metal pin of claims 14 and 28 in col. 3, lines 9-11.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use metal for the pin to accommodate for the knee's full range of motion and give the implant's pin its desired strength and durability.

Response to Arguments

Applicant's arguments with respect to claims 1 and 15 have been considered but are not persuasive due to the definition of the word perimeter as given above, and are moot in view of the new ground(s) of rejection. Their dependent claims are also in condition for rejection, due to the citations given above and the dependency on the rejected claims 1 and 15.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger
November 13, 2006


ALVIN J. STEWART
PRIMARY EXAMINER